

REMARKS

The Office Action of 30 June 2006, rejected claims 1-6, 9 and 59-71 under 35 U.S.C. §112, first paragraph, as allegedly “failing to comply with the written description requirement.” *Office Action of June 30, 2006*, page 2. Specifically, the Action stated that the claims “contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” *Office Action of June 30, 2006*, pages 2-3. Applicants respectfully disagree with the assertion that the specification as filed does not fully support the presently claimed invention.

To support this notion that the specification does not evince possession of the claimed invention, the Office Action appears to be searching for, and requiring, the presence of *ipsis verbis* support in the specification for claim 1. Such a description, however, is not required in the specification to support the claims. Rather, “the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.” *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 1999). Indeed, the standard for determining if a specification complies with the written description requirement is that “the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991) (quoting *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989)).

Accordingly, Applicants assert that the specification as filed would allow one of ordinary skill in the art to recognize or visualize that presently claimed invention; albeit not in *ipsis verbis* terms. As highlighted in the Amendment under 37 C.F.R. §1.114, filed 5 April 2006, the specification provides ample support for illuminating the particles using white light when it states that “different colors of scattered light [can be generated upon] illumination of polychromatic light, such as white light.” U.S. Pregrant Publication No. 2002/0127561, ¶0056. The specification also provides support for the concept that the illuminating light, which may certainly include white light, can be non-evanescent when it states that “the methods of this

invention [may] use illumination with non-evanescent wave light,....” U.S. Pregrant Publication No. 2002/0127561, ¶0046. Further, there is no explicit teaching or even suggestion that, when white light is used as the illuminating light, the wave light must not be evanescent. Thus, one of skill in the art would easily recognize and be able to visualize that the non-evanescent light that is used to illuminate the particles may also be white light. Accordingly, the specification taken as whole would allow one of skill in the art to visualize the presently claimed invention. Applicants earnestly solicit reconsideration and withdrawal of the written description rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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